

## REMARKS

This communication is a full and timely response to the Office Action dated November 13, 2009. Claims 23-34 remain pending, where claim 1-22 were previously canceled. By this communication claim 23 is amended for clarity.

Entry of this Amendment is deemed proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to formal issues raised in the final rejection.

In numbered paragraph 1 on page 2 of the Office Action, claim 23 is objected to for alleged informalities. Claim 23 is amended in a manner that addresses the stated concern. Withdrawal of this rejection, therefore, is respectfully requested.

Also on page 2 of the Office Action, claims 23-34 stand rejected under 35 U.S.C. §103 for alleged unpatentability over *Nomura* (US 6,338,904) in view of *Dodson, III* (US 6,958,552). Applicants respectfully traverse this rejection.

Among other features, independent claim 23 recites:

- an electric power inverter for converting first dc power received through an overhead wire to second dc power, and supplying the second dc power to a dc load;
- an electric power supplier for converting the first dc power received through the overhead wire to third dc power; and
- a controller for receiving power from the power-outputting unit, and controlling the electric power inverter.

Contrary to the remarks in the Office Action, *Nomura* does not disclose or suggest at least the foregoing features. *Nomura* is directed to a power supply device that includes H-type inverter bridges 58 and 59 that are connected in **serial** to a first

DC voltage. Rectifier circuits 68, 69 receive the output of the H-type inverter bridges 58, 59 via a pair of insulating transformers 31, 32. A smoothing circuit 7 receives the output from the rectifying circuit 68, 69 and generates a second DC voltage. *Nomura* discloses that the combination of the H-type inverter bridges 58, 59, the insulating transformers 31, 32, and the rectifying circuit 68, 69 control the high voltage state of the first DC voltage to obtain a constant DC voltage suited for a three-phase AC voltage 13 that is generated by three-phase inverter 9.

In particular, the H-type inverter bridges 58 and 59 are used to effectuate load sharing with respect to the first DC voltage. See Nomura, col. 4, lines 30-49. Thus, the output of both respective rectifier circuits 68 and 69 is needed to suitably **generate the second DC voltage at the output of the smoothing circuit 7.**

Based on this guidance, one of ordinary skill would understand that *Nomura* does not disclose and cannot reasonably be interpreted to disclose both an electric power inverter and an electric power supplier as recited in claim 23.

On page 3 of the Office Action, the PTO alleges that *Nomura* discloses an electric power inverter through elements 6, 21, and 58 and an electric power supplier is taught through elements 22, 32, 59, and 69. Applicants disagree with this interpretation and submit that a more prudent interpretation of *Nomura* finds that because of the established load sharing of the first DC voltage, elements 6, 21, 22, 31, 32, 58, 59, 68, 69, and 70, among others, form a power inverter. Any other interpretation is seemingly converse to the circuit described and represented in relation to Figure 1 of *Nomura*.

The PTO also asserts that *Dodson, III* discloses a power-outputting unit as recited in claim 23. While not acquiescing to this interpretation of *Dodson, III*, even

assuming *arguendo* that this interpretation is reasonable, one of ordinary skill would not have combined the subject features of *Dodson, III* with *Nomura* as alleged. Because *Nomura* discloses the use of serially connected converter circuits in a load-sharing arrangement, there is no apparent need to include a voltage regulating circuit as described in *Dodson* since the output of both converter circuits is needed to generate the second DC voltage. Integrating the circuit of *Dodson* into the circuit of *Nomura*, as alleged, would likely result in *Nomura* being incapable of suitably achieving its stated objective of generating the second DC voltage.

Based on the above reasoning, it follows that the combination of *Nomura* and *Dodson, III* also does not disclose or suggest the features recited in dependent claims 24-34. Particularly, because *Nomura* effectively discloses the use of two power converters in a single power inverter to generate a second DC voltage at the output of a smoothing circuit, the alleged combination cannot disclose supplying third DC power to a controller as recited in claims 25 and 27.

The courts have established that to prove *prima facie* obviousness, the Office has the burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal

conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

Based on the foregoing remarks and the criteria for proving obviousness, Applicants submit that *Nomura* and *Dodson, III* when applied individually or collectively as alleged in the Office Action, fail to disclose or suggest every feature recited in Applicants' claims such that a *prima facie* case of obviousness is established. Accordingly, withdrawal of this rejection is respectfully requested.

### **Conclusion**

Based on the foregoing remarks, Applicants respectfully request favorable consideration of claims 23-34 and allowance of this application. In the event any unresolved issues remain, the Office is invited to contact Applicant's representative identified below.

Respectfully submitted,

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